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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,944	02/04/2000	Christopher Warnock	EBRY0001	9493

22862 7590 03/22/2007
GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER

LE, NANCY LOAN T

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.	Applicant(s)	
	09/498,944	WARNOCK ET AL.	
	Examiner	Art Unit	
	NANCY T. LE	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 15, 17-21, 55-75 and 78-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 15, 17-21, 55-75 and 78-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/16/06 & 6/27/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-3, 15, 17-21, 55-75 and 78-85 have been examined and pending in the present application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 67 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter (i.e., "*a document server*", "*delivering to ... via a document server*", "*... actual contents of said specific document residing at said document server comprising said ...*") which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention (i.e., new subject matter).

Claims 2, 3, 15, 17-21, 55-66, 68-75 and 78-85 are also rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement as they depend from the above-rejected claims 1 and 67.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 67 are rejected under 35 U.S.C. §102(b) as being anticipated by LeBOURGEOIS (International PCT Publication No. WO 98/42098, published on 09/24/1998).

As per **claim 1**, LeBOURGEOIS discloses a method for allowing a user to access document content using a logic client device comprising:

- delivering to a user of said client logic device, via a document server, a first user viewable version of the actual contents of a specific document residing at a said document server on a first cost basis, said first user viewable version being protected by a security server to prevent the user from performing standard operations on said version such as copying, printing or saving (As there is no support for the element of “***delivering to ... via a document server***”, the Office interprets this feature of the claim to be “*providing a user of said client logic device with a first user viewable version of the actual contents of documents residing at a server on a first cost basis, said first user viewable version being protected by a security server to prevent the user from performing standard operations on said version such as copying, printing or saving*” – see pg. 10 line 28 – pg. 11 line 1, pg. 19 lines 19-32);
- calculating with said document server a charge to permit the user to perform a requested standard operation on a user-selected portion of said specific document on a second cost

basis (As there is no support for the element of “... *with said document server*”, the Office interprets this feature of the claim to be “*calculating a charge to permit the user to perform a requested action on a user-selected portion of document content on a second cost basis*” -- see pg. 11 lines 1-9, pg. 26 lines 13-18, pg. 28 line 24 – pg. 29 line 6);

- delivering to said user, via said document server, a second version of the actual contents of said specific document residing at said document server comprising said user-selected portion of said specific document, wherein a user requested standard operation is completed, in coordination with said document server, upon payment of the calculated charge (As there is no support for the elements of “*a document server*”, “*delivering to ... via a document server*”, “... *actual contents of said specific document residing at said document server comprising said ...*”, the Office interprets this feature of the claim to be “*providing a second version of the user-selected portion on which a user requested action is completed, in coordination with said security server, upon payment of the calculated charge*” -- see pg. 11 lines 9-15).

As per claim 67, LeBOURGEOIS discloses a method for allowing the purchase of information from a server, comprising:

- delivering user-requested pages of a specific document from a document server in a first user-viewable version comprising a form protected by a security server to a user of a client logic device to permit said user viewing the actual contents of said pages of said specific document and selecting by said user but not printing, copying or saving by the user (As there is no support for the elements of “*a document server*”, “*delivering to ... via/from a document server*”, “... *in a first user-viewable version comprising a ...*”, the Office interprets this feature of the claim to be “*serving/providing user-requested pages of information from a server in a form protected by a security server to a user of a client logic*”

device to permit user viewing of the actual contents of said pages of information and selecting by a user but not printing, copying or saving by the user” – see pg. 10 line 28 – pg. 11 line 1, pg. 19 lines 19-32);

- calculating a charge with said document server to permit a requested standard operation to be performed on a user-selected portion of said specific document (As there is no support for the elements of *“a document server”*, the Office interprets this feature of the claim to be *“calculating a charge to permit a requested action to be performed on a user-selected portion of the information served”* – see pg. 11 lines 1-9, pg. 26 lines 13-18, pg. 28 line 24 – pg. 29 line 6); and
- delivering the user-selected portion, via said document server, in coordination with said security server, upon authorization of payment of the calculated charge in a second version comprising a form on which the standard operation is performed (As there is no support for the elements of *“a document server”*, *“delivering to ... via/from said document server”*, *“... in a second version comprising a ...”*, the Office interprets this feature of the claim to be *“providing the user-selected portion in coordination with said security server, upon authorization of payment of the calculated charge in a second form on which the requested action is performed”* – see pg. 11 lines 9-15).

Conclusion

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Art Unit: 3621

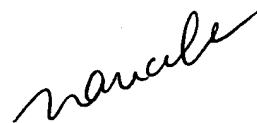
Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY LOAN T. LE whose telephone number is **(571) 272-7066**. The examiner can normally be reached on Monday - Friday, 9am - 6:00pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW J. FISCHER can be reached on **(571) 272-6779**.

For official/regular communication, the fax number for the organization where this application or proceeding is assigned is **(571) 273-8300**.

For informal/draft communication, the fax number is **(571) 273-7066 (Rightfax)**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197 (toll-free)**.



Nancy Le

Patent Examiner

19 March 2007



ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600